

# Notice of Allowability

Application No.

10/789,760

Examiner

Sue A. Purvis

Applicant(s)

LEONARDI, PAULO

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to application filed 27 February 2004.
2. ☒ The allowed claim(s) is/are 1-22.
3. ☒ The drawings filed on 27 February 2004 are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☒ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

## Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date \_\_\_\_\_
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-22, drawn to a device for placing a label onto a disk and method of using that device, classified in class 156, subclass 391.
  - II. Claim 23, drawn to a method of manufacturing the labeling device, classified in class 264, subclass 328.1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed could be made by a different process, for example a different molding process.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Anastasia Heffner on Monday, August 16, 2004 a provisional election was made without traverse to prosecute the invention of the device and method of using that device, claims 1-22. Claim 23 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Examiner's Amendment***

5. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Anastasia Heffner on Monday, August 16, 2004.

The application has been amended as follows:

In the claims,

Cancel claim 23.

***Priority***

6. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Allowable Subject Matter***

7. Claims 1-22 are allowed.

8. The following is an examiner's statement of reasons for allowance: Prior art fails to teach or suggest a labeling device as defined in claim 1 of the instant application. In particular, claim 1 requires that a labeling device include a centering member (7), a centering part (8), and a base member (9) in combination with an outer ring (10). The outer ring (10) in the instant invention also includes a flexible tongue (15,16) in a groove (17,18) with a flexible supporting beam (22,23) which extends radially inward. The instant device also has a profile part (45) for adapting the device to the external profile of the label. The closest prior art Miller (US Patent No. 6,273,167 B1) discloses an embodiment in Figure 6 which shows flexible arms (117) which extend radially inward, but the arms do not start in

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the outer ring of the base, as they do in the instant invention. The outer ring of the base in Miller is a smooth surface and not modified as in the instant invention. Furthermore, there is no reason or suggestion for modifying the outer ring in Miller. Prior art reference Koch '654 (US Patent No. 6,347,654 B1) also discloses radial slots which flex, but again these slots do not extend to the outer wall of the labeling device, nor is there a reason or suggestion for doing so. Atkinson (US Patent No. 6,321,811 B1) discloses a CD labeler with parts (16,18) adaptable based on the type of CD to be labeled.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Koch '957 (US Patent Application Publication No. 2002/0174957) is a reference of interest because it uses radial slots in a CD labeler. Koch '654 discloses the labeler is preferably a molded as a single-piece plastic component. (Col. 3, lines 61-65.) Hummell et al. (US Patent No. 6,318,436 B1) discloses that it is known to use injection molding to make CD labelers. (Col. 4, lines 9-19.)

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A. Purvis whose telephone number is (571) 272-1236. The examiner can normally be reached on Monday through Friday 9am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Sue A. Purvis", with a long horizontal line extending to the right.

Sue A. Purvis  
Primary Examiner  
Art Unit 1734

SP  
August 16, 2004